

Remarks/Arguments

A. Status of the Claims

Claims 2, 4, 5, and 13 are revised, and claims 14-19 are added. Support for the revisions and new claims can be found throughout the specification and claims as originally filed.

Claims 1-19 are pending.

B. The Anticipation Rejection Should Be Withdrawn

Claim 13 is rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent 5,258,225 ("Katsamberis").

Applicant respectfully disagrees. In order to support the anticipation rejection, every element of the rejected claims must be "identically shown" in this reference. *See In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990) ("For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference."). This standard is not met with respect to present claim 13 *vis-à-vis* the disclosure made in Katsamberis.

By way of example, claim 13 now concerns a "(meth)acrylate based coating composition comprising: i) at least one (meth)acrylate compound and ii) at least one compound I having at least one -M-Z' bond with M representing Si or a Metal atom, Z' representing OH or a hydrolysable group, and at least one epoxy group....". Note that Z' includes an epoxy group.

By comparison, Katsamberis appears to disclose a composition comprising, *inter alia*, (a) acrylic monomers and (b) functionalized colloidal silica. With respect to (b), Applicant respectfully notes that the functionalized colloidal silica does not appear to include an epoxy group. This point is illustrated at col. 5, lines 26-52 of Katsamberis. Stated another way, this reference fails to disclose Applicant's claimed compound I.

The current anticipation rejection should be withdrawn, as Katsamberis fails to disclose every element of the claimed invention. *See In re Bond*, 910 F.2d at 832.

C. The Obviousness Rejection Should Be Withdrawn

Claims 1-13 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent 7,217,440 ("Jallouli") in view of Katsamberis.

Applicant respectfully disagrees with this rejection. It is improper to cite Jallouli as prior art to the claimed invention. For instance, the claimed invention claims priority to October 22, 2004 through a provisional application. Support for the current claims can be found in the provisional application (*see, e.g.*, original claims). The assignee of the present application is Essilor International Compagnie General d'Optique ("Essilor").

By comparison, Jallouli, which is assigned to Essilor, issued on May 15, 2007 (*see* U.S. Patent 7,217,440), published on December 16, 2004 (*see* U.S. Publication 2004/0253369), and was filed on June 13, 2003. Therefore, the Jallouli qualifies as prior art to the claimed invention only under 35 U.S.C. § 102(e)(2) (note that 102(c), (d), (f), and (g) are not germane here).

Under the fact situation described above, it is improper to use Jallouli to support the current obviousness rejection in view of 35 U.S.C. § 103(c)(1), which states:

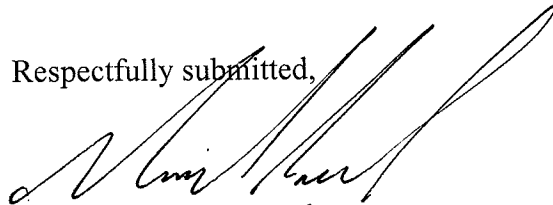
(c)(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Applicant requests that the obviousness rejection be withdrawn.

D. Conclusion

Applicant believes that this case is in condition for allowance and such favorable action is requested. The Examiner is invited to contact the undersigned Attorney at 512.536.3020 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



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